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REMARKS

1. The Examiner has maintained his obviousness objection to claims 1-5, 7, 8, 12, 14-20, 22, 23, 27-29, 32 47-51 and 54-58 on the basis of Cass (US 5,692,073) in view of LaMarca (US 6,279,013) and has made this official action final.

2. In relation to claims 1 and 47, the Examiner has suggested that Cass discloses a system in which *"at least one interactive element enables a user to indicate a request for further directory information by interacting with the element using a sensing device which is adapted to transmit request data 2200 to a computer system."* The Applicant observes that Cass does not disclose any interactive elements as claimed.

In Claim 1, the interactive element is defined as one *"which enables a user to indicate a request for further directory information by interacting with the at least one user interactive element using a sensing device."* There is no such interactive element in Cass which meets this description. There is no disclosure of a user using a sensing device to interact with any interactive elements. The closest equivalent to the claimed sensing device is the scanner or fax machine in Cass. However, the user does not use this scanner to interact with any interactive elements. Instead, the user uses an ordinary pen to make markings on directory entries printed on the paper (Col. 17 lines 4-16). The Cass system detects the presence of written marks on the document by scanning the pen-marked document into the system and comparing it with an unmarked document stored in the system. The differences in the pixels of the two documents indicate the markings made by a user.

At no stage does the user in the Cass arrangement *"interact"* with any interactive elements by using the scanner. Instead, the user simply makes a cross mark on the page using an ordinary pen and the Cass scanner scans in the whole page and interprets those markings.

Similar comments apply in relation to claim 47. The Applicant submits that Cass does not disclose *"at least one user interactive element which enables a user to indicate a request for further directory information by interacting with the at least one user interactive element using a sensing device"* as claimed in claims 1 and 47.

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3. In relation to claims 16 and 54, the Examiner has suggested that "*Cass teaches ... at least one user interactive element to enable a user to request further directory information*" and "*a sensing device for interacting with the at least one user interactive element.*" In contrast, the Applicant submits that Cass does not disclose such an interactive element, nor a sensing device which is adapted to interact with such an interactive element.

In the Cass system, the user uses an ordinary pen to make markings on an ordinary piece of paper. There is nothing about the printed directory entries of Toucans and Monkeys of Cass' Figure 21 to suggest that they are "*interactive elements*" which are in some way adapted to be interacted with using a sensing device. Furthermore, as mentioned above, the "*sensing device*" in Cass is a fax machine or scanner which is never used by a user to "*interact*" with anything on Cass' printed page. Instead the scanner scans in the entire page so that the system can compare the pixels on a marked page with the pixels on a stored page.

Cass therefore does not disclose any "*interactive elements*" as claimed in claims 16 and 54.

4. The Examiner suggests that "*LaMarca teaches that the list of directory entries and the coded data are printed substantially simultaneously.*" In reply, the Applicant submits that LaMarca does not disclose any printing of any directory entries at all. LaMarca is concerned with a personalised newspaper subscription service in which users are able to indicate whether they want more less or none of a particular subject matter.

The passages quoted by the Examiner make no mention of directory entries or equivalent features. LaMarca therefore does not disclose a system in which "*the list of directory entries and the coded data being printed substantially simultaneously*" as claimed in claims 16 and 54.

5. The Examiner suggests that "*La Marca teaches a user interactive element [tokens 18, 20, 22, 24, 60, 62, 64 and 66] with coded data [dataglyphs] indicative of an identity of the document and an identity of the at least one user interactive element.*" In response, the Applicant makes the following points:

(a) The Applicant notes that the Examiner has left out the claimed feature that the coded data is indicative of "*a position of the at least one user interactive element.*" This is clearly

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because the coded data in LaMarca is not indicative of the position of the user interactive element. There is no disclosure of the LaMarca coded data being so indicative.

(b) The Examiner has equated the "tokens" of LaMarca with the "user interactive elements" as claimed. The Applicant submits that LaMarca's tokens are not the same as the claimed "user interactive elements." The LaMarca system works in one of two ways:

(i) In a first embodiment, users wishing to indicate whether they want to read more or less of a particular newspaper subject matter use an ordinary pen to tick the "more" or "less" sections of the printed page. In order for the system to register the user's preference, the LaMarca system does the following:

"... if communication is desired with the publisher then the document can be disposed into a recycling bin and provided to a scanner 46 which will recognize the dataglyphs to identify the document, the edition, the subscriber and those redactions placed on the document by the reader. The scanning information is communicated to a segmenter, token decoder 48, which determines the dataglyphs and redactions and translates them into a form which can be communicated as meaningful information to a publisher including an update of the subscriber's profile 50 for adjusting the subscriber's profile in the profile storage 32."

In this first embodiment, the whole page is scanned in by a scanner and the user's marks (redactions) are then interpreted by the system. It is not clear whether the "tokens" play any part in capturing the user's preference in this embodiment. What is clear, however, is that this embodiment does not disclose "at least one user interactive element which enables a user to indicate a request for further directory information by interacting with the at least one user interactive element using a sensing device" as claimed in claim 1. As with Cass, the user uses an ordinary pen to tick boxes or make crosses on the paper. The LaMarca sensing device, as with Cass, is a scanner. As such, the user does not use any sensing device to indicate a request for further directory information by interacting with any user interactive elements. Furthermore, the result of the user's marks is not "further directory information" but is merely the update of the user's profile in the system.

(ii) In the second LaMarca embodiment, a "smart wand 70" is used. The Examiner suggests that "LaMarca teaches a sensing device [smart wand 70] for interacting with the at least one user interactive element and transmitting request data to the computer system to facilitate the further directory information being sent from the computer system to the

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printer for printing in a further document, the request data being indicative of the identity of the document and an identity of the at least one interactive element.” The LaMarca wand has three buttons or switches on it which a user can press to indicate whether they would like “more”, “less” or “no” further information about a particular subject. LaMarca describes how the wand is used as follows:

“As seen the flow-chart of Fig. 4, at step 80, the user while reading the document can position the wand over an associated token to a particular article, wait for token identification confirmation and then control the wand to indicate preferences by operating the control switches 72, 74 and 76.”

In this embodiment, the wand is not a sensing device which *“enables a user to indicate a request for further directory information.”* The wand is described here with very limited functionality and is presented not in the context of navigating a directory but in the context of indicating a user’s preference about a particular news subject. The result of the wand’s actions is not a request for further directory information, but merely the updating of a user’s profile in the system.

LaMarca therefore does not disclose *“at least one user interactive element which enables a user to indicate a request for further directory information by interacting with the at least one user interactive element using a sensing device”* as claimed.

6. On pages 4 and 5 of the official action, the examiner quotes a number of passages from LaMarca in order to support an argument that LaMarca invites a combination with Cass. In response, the Applicant makes the following points:

(a) The Applicant notes that the passages quoted by the Examiner only say that the purpose of LaMarca is to personalise the content of the newspaper. This personalisation is achieved by users indicating if they want to see more or less of a particular item and this information is stored in a user profile. There is no disclosure or suggestion in LaMarca of any desire or need for navigating a directory.

(b) The Examiner has attempted to combine the *“smart wand”* of LaMarca with the system disclosed in Cass in order to attempt to anticipate the claimed invention. However, Cass teaches away from a combination with any sort of pointing device when it states in lines 28 to 34 of column 7:

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"Notably absent from hardware components 101 are a keyboard, mouse or other pointing device, and display screen. Such components, while typically part of most computers, are not necessary to the invention. This is because such components are adapted for providing (for example) a graphical user interface, whereas here the focus is on paper-based user interface."

If one of ordinary skill in the art read this section of Cass at the time the invention was made, they would be discouraged from combining the Cass disclosure with any other system (such as LaMarca) which incorporates a pointing device (the "smart wand"). For these reasons, the Applicant submits that there is no motivation to combine Cass with LaMarca.

7. In relation to claims 8 and 23 the Examiner suggests that *"Cass teaches the step of using the sensing device to select an individual entry in the list."* In reply, the Applicant submits that the user in Cass selects an individual entry in the list using an ordinary pen. The user does not use the Cass scanner in any selection process. Cass therefore does not anticipate claims 8 and 23.

8. In relation to claims 14 and 32 the Examiner suggests that *"Cass describes a database 520 for keeping a retrievable record of each document 521. Each document is retrievable by using its identity, as included in its coded data."*

However, the documents in the Cass arrangement do not contain any coded data. They are indexed in the Cass database not with reference to any coded data but with reference to the scanned image itself (See col. 10, lines 35-45 and col. 8, lines 30 to 35).

Cass therefore does not disclose:

"A method as claimed in claim 1, including retaining a retrievable record of the printed document, the document being retrievable using the identity data as contained in the coded data"

as claimed in claim 14. Similar comments apply in relation to claim 32.

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9. In relation to claim 15 the Examiner suggests that "*Cass describes retaining a retrievable record of the printed document.*" However, claim 15 does not relate to this feature, but states:

"A method as claimed in claim 1, wherein the sensing device includes an identification code specific to a particular user and the method includes monitoring use of the sensing device in the computer system."

The Applicant suspects that the Examiner may be referring to another claim. The Applicant is not able to fully respond to the Examiner's objection and requests that it be re-stated.

10. In relation to claim 27 the Examiner suggests that "*Cass describes using such a system to keep track of a particular user.*" However, claim 27 states:

"A system as claimed in claim 16, wherein the sensing device includes an identification code specific to a particular user and the computer system is arranged to monitor the use of the sensing device."(Emphasis added)

Cass does not disclose a sensing device with an identification code specific to a particular user. Furthermore, the Cass scanner is intended to be used by a plurality of individuals and is not associated in any way with a particular user. The passages cited by the Examiner do not contain the features of claim 27 as alleged.

11. In relation to claim 28, the Examiner suggest that "*Cass describes making marks on the documents.*" In reply the Applicant notes that in Cass, the marks are made on the documents by an ordinary pen and not by the "*sensing device*" (fax/scanner) as is claimed in claim 28.

12. In paragraph 5 of the Office Action, the Examiner has attempted to combine Cass with LaMarca and Dymetman (US 6,330,976) in order to suggest that claims 10, 11, 13, 25, 26, 31, 34-46, 52, 53, 59 and 60 are obvious. However, as stated in paragraph 6(b) above, Cass teaches away from any combination with a pointing device. Since Dymetman discloses

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such a pointing device, one of ordinary skill in the art at the time the invention was made would not have had any motivation to combine Cass with Dymetman.

13. In relation to claim 11, the Examiner suggests that Dymetman teaches "*identifying the request in the computer system.*" Since this claim depends from claim 10 which, in turn depends from claim 1, the "*request*" is clearly the "*request for further directory information.*" There is no disclosure in Dymetman that the request is for further directory information, as suggested by the Examiner.

14. In relation to claims 34 and 41 the Examiner suggests that in Dymetman "*the indicating data is indicative of a position of the sensing device relative to the list of directory entries.*" However, the Applicant submits that there is no disclosure in Dymetman of any list of directory entries and there is certainly no such disclosure in the passages cited by the Examiner. There is therefore no disclosure in Dymetman of "*indicating data indicative of both an identity of the list of directory entries and a position of the sensing device relative to the list of directory entries*" as claimed in claims 34 and 41.

15. In relation to claims 39, 52 and 59 the Examiner argues that "*Dymetman teaches receiving ... further directory information relating to a selected node of the index of the directory.*" However, the Applicant submits that there is no disclosure in Dymetman of any nodes or any index of a directory and there is certainly no such disclosure in the passages cited by the Examiner. There is therefore no disclosure in Dymetman of a method which involves "*identifying, in the computer system and from the movement data, further directory information relating to a selected node of the index of the directory*" as claimed in claims 39, 52 and 59.

16. In relation to claim 46 the Examiner argues that "*Dymetman teaches that the computer system is adapted to ... interpret said movement of the sensing device as it relates to said at least one node of the index.*" However, the Applicant submits that there is no disclosure in Dymetman of any nodes or any index and there is certainly no such disclosure in the passages cited by the Examiner. There is therefore no disclosure in Dymetman of a

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system which is adapted to *"interpret said movement of the sensing device as it relates to said at least one node of the index"* as claimed in claim 46.

17. The Applicant submits that Cass teaches away from a combination with any pointing device related prior art and therefore one of ordinary skill in the art at the time the invention was made would have no motivation to combine Cass with LaMarca or Dymetman. Furthermore, the Applicant has pointed out numerous claimed features which are not contained in the citations. The Applicant submits for these reasons that the Examiner's obviousness objections are not well founded and requests that the Examiner withdraw them.

18. Finally, the Applicant challenges the Examiner's decision to make this action final for the following reasons:

- (a) The Office Action raised LaMarca as entirely new prior art. By making this action final the Examiner has limited the Applicant's ability to fully consider and respond to this new prior art.
- (b) The Examiner's objection in relation to claim 15 is unclear, as mentioned in paragraph 9 above. As such the Applicant is unable to fully respond to this Office Action.

The Applicant requests that the Examiner reconsider his decision to make the previous Office Action final.


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CONCLUSION

It is respectfully submitted that all of the Examiner's objections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

Applicant:



PAUL LAPSTUN



KIA SILVERBROOK

C/o: Silverbrook Research Pty Ltd
393 Darling Street
Balmain NSW 2041, Australia

Email: Kia.silverbrook@silverbrookresearch.com

Telephone: +612 9818 6633

Facsimile: +61 2 9818 6711



SILVERBROOK RESEARCH Pty Ltd
393 Darling Street Balmain NSW 2041 Australia
PO Box 207 Balmain NSW 2041 Australia
Phone: +61 2 9818 6633 Fax: + 61 2 9818 6711
Email: info@silverbrookresearch.com
ACN 086 573 671

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Attached is a response to Office Action of Examiner, Leland R Jorgensen, dated November 25, 2002.

Regards

PP: Leonie News
Silverbrook Research Pty Ltd

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